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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAYLOR MADE GOLF CO., INC.

Appeal 2008-3584
Application 10/622,006
Technology Center 3700

Decided: September 15, 2008

Before JAMESON LEE, RICHARD TORCZON, and JAMES T. MOORE,
Administrative Patent Judges.

Opinion filed by TORCZON, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Claims 1, 3-6, 10, 12, 13, 16, and 17 stand rejected under 35 U.S.C. § 103 (Ans. at 3-5). The appellant (Taylor Made) seeks review under 35 U.S.C. § 134. We AFFIRM.

The examiner relies on the following prior art in rejecting the claims
(Ans. at 2):

Rosenow	US 3,145,749	25 August 1964
Lauretti	US 2,422,245	17 June 1947
Russell	US 3,161,932	22 December 1964
Kurt	US 3,008,209	14 November 1961

THE CLAIMS

The claimed invention relates to a golf head cover having a cover body formed of flexible, non-rigid material that is held closed by magnetic fasteners (Spec. at 0006). We reproduce Taylor Made's Figures 1 and 3 below:

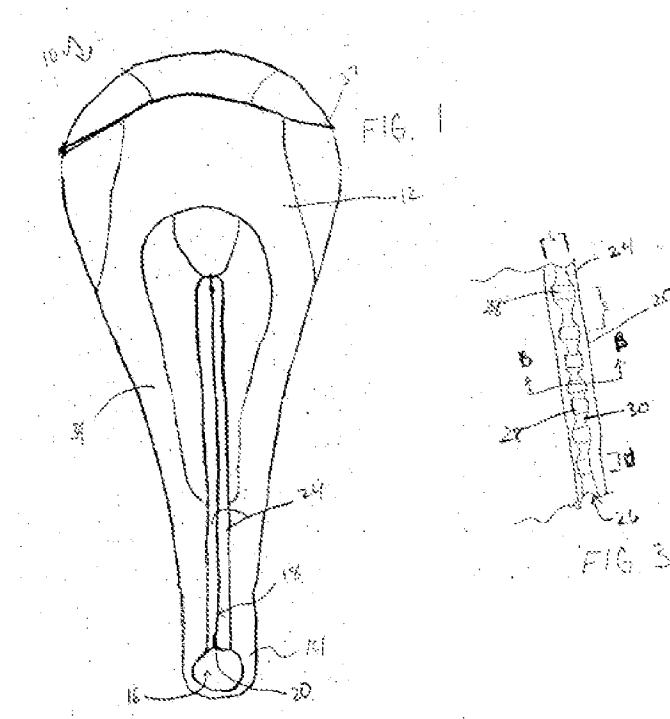


Figure 1 depicts a front view of a golf head cover and Figure 3 is a close-up cross-sectional view of the fastener (Spec. at 3).

Taylor Made alleges that the examiner improperly used two non-analogous art references in rejecting the claims (Br. at 5). Taylor Made also contends the examiner improperly combined the references (Br. at 5-9). Taylor Made does not offer separate arguments for each of the rejected claims. Claims stand or fall together if they are not argued separately. 37 C.F.R. § 41.37(c)(1)(vii). We select independent claim 1 as broadly representative of the claims on appeal and reproduce it below (Br. at 11) (drawing numbers added as shown in Taylor Made's FIG. 1 and FIG. 3 above):

A head cover **10** with golf club assembly comprising:
a golf club having a head;
a cover body formed essentially of flexible, non-rigid material, the cover body defining an inner compartment **12** accommodating the head, the body also defining a lower portion **14** for surrounding at least a portion of a shaft of the golf club and formed with at least first and second longitudinal edges **20** generally parallel to the shaft, the edges **20** meeting each other in a closed configuration, the edges **20** being distanced from each other in an open configuration;
at least a first elongated magnetic fastener **26** positioned along the first edge; and
at least a second elongated magnetic fastener **26** positioned along the second edge and being attracted to the first magnetic fastener to hold the edges **20** together in the closed configuration.

Issue

(1) Were the prior-art references sufficiently analogous to combine properly?

(2) Was the modification of golf-club covers with magnetic closures consistent with the teachings in the cited prior art?

Findings of Fact

1. Taylor Made discloses an inner liner formed from soft, flexible material, like cotton, that is not abrasive to the golf club head (Spec. at 0021).
2. Flexible materials, like leather and neoprene, are used for the outer cover (Spec. at 0021).
3. An elongated fastener **18** uses magnetic strips **26** to fasten the cover (Spec. at 0019).
4. The magnetic strips **26** along the longitudinal edges **20** are aligned to close the cover (Spec. at 0019 and Taylor Made FIG. 1, above).
5. The magnetic strips **26** are located within the hollow cord **24** of each longitude edge **20** (Spec. at 0019 and Taylor Made FIG. 3, shown above).
6. The magnetic strips **26** have a plurality of generally cylindrical magnets **28** (Spec. at 0020).
7. The Rosenow patent discloses using pliable materials, like leather, fabric, and plastic, for the outer cover of a golf club head cover that fits snugly over the club head (Rosenow, col. 1, l. 54 to col. 2, l. 2).
8. Rosenow's cover **7** uses a conventional zipper-type closure **17** (Rosenow, col. 2, ll. 10-13 and Rosenow FIG. 1, shown below).

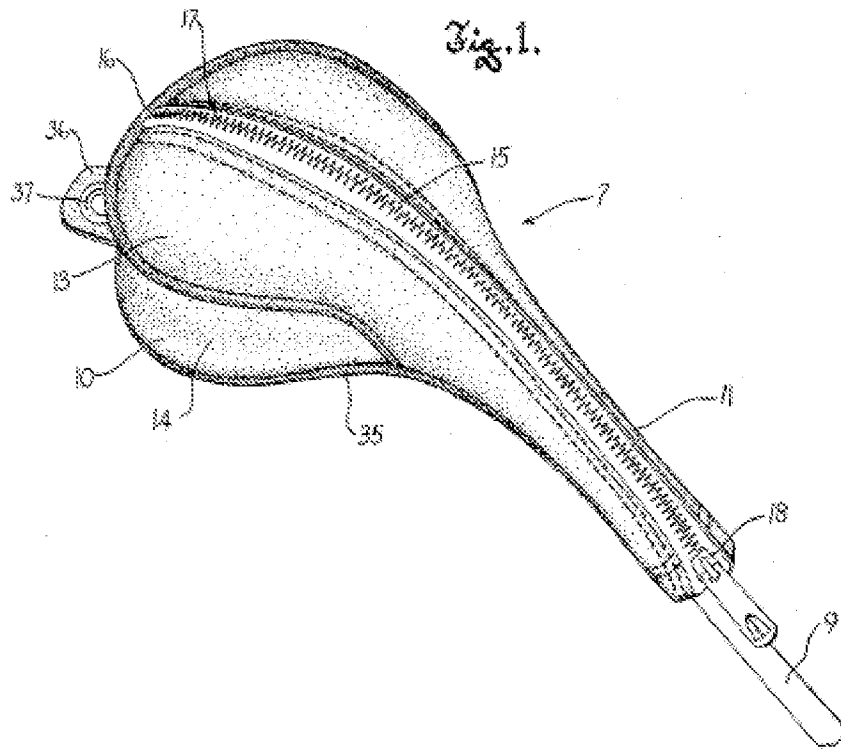


Figure 1 is a perspective view of Rosnow's cover.

9. The Lauretti patent discloses a golf club head cover with an inner liner formed from soft materials (Lauretti, col. 2, ll. 53-55).

10. Lauretti's outer cover uses leather formed to fit snugly over the club head (Lauretti, col. 1, l. 51 to col. 2, l. 5).

11. Lauretti uses a zipper-like slider fastener **16** to close the cover (Lauretti, col. 2, ll. 40-44 and Lauretti FIG. 5 below).

15. Russell's magnetic strips **10** have a plurality of generally flat, circular magnets **12, 13** (Russell, col. 1, ll. 48-53).

16. The Kurt patent discloses using magnetic fasteners for any form of fabric, cloth, cover, garment, apparel, tarpaulin, bag, container, or other device, that requires closure along a seam (Kurt, col. 4, ll. 6-10).

17. Kurt contends that magnetic fasteners are easy opening and closing fasteners (Kurt, col. 1, ll. 7-23).

18. Kurt also contends that a magnetic fastener is better than conventional zipper because it will not foul, jam, or become inoperative by catching foreign material in the fastener (Kurt, col. 1, ll. 11-15).

19. Kurt uses continuous magnetic strips **11** for heavy material and outdoor applications (Kurt, col. 4, ll. 10-13 and Kurt FIG. 1, shown below).

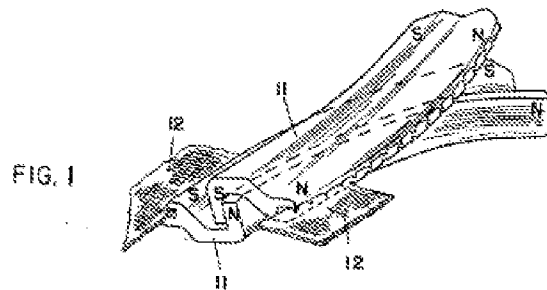


Figure 1 is a perspective view of an improved type of zipper.

20. According to Taylor Made, the difference between the cited prior art and the claimed invention lies not in some missing element, but rather in differences in the fields of the art and the consequent lack of a teaching or suggestion to combine the teachings in the prior art (Br. at 5-9).

21. A person of ordinary skill in the art would have known that using a golf club head cover reduces damage to the golf club (Lauretti, col. 1, ll. 12-15).

22. Taylor Made defines a need for a head cover that is relatively simple to install and remove (Spec. at 0005).

Principles of Law

A prior-art reference is considered analogous if, among other possibilities, it is reasonably pertinent to the particular problem facing the inventor. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Factors relevant to whether teachings are properly used together include (1) the field of inquiry, (2) the subject matter of the references, (3) the extent to which they are in the same or related fields of technology, (4) the nature of the advance made by the applicant, and (5) the maturity and congestion of the field. *In re Johnston*, 435 F.3d 1381, 1385 (Fed. Cir. 2006).

In analyzing obviousness, the scope and content of the prior art must be determined, the difference between the prior art and the claim ascertained, and the ordinary level of skill in the art resolved. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966). The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. *KSR Int'l Co. v. Teleflex Inc.* 127 S.Ct. 1727, 1739 (2007).

Analysis

Taylor Made's claimed invention relates to a golf club head cover having a cover body formed from flexible, non-rigid material. Magnetic fasteners hold the cover closed without the use of a conventional zipper (Findings 3-5). Rosenow and Lauretti disclose generally similar covers that fits snugly over a golf club head (Findings 7 and 10). These covers use

zipper closures (Findings 8 and 11). According to Taylor Made, it is improper to combine the Kurt and Russell magnetic fasteners with the Rosenow and Lauretti golf club head covers because the references are not analogous art (Br. at 5-6).

A prior-art reference is analogous if it is reasonably pertinent to the particular problem with which the inventor is involved. Taylor Made defines a need for a golf club head cover that is easy to install and remove (Finding 22). Taylor Made's cover liner is made from a soft material, like cotton fabric (Finding 1). Taylor Made's outer cover is made from flexible, non-rigid material (Finding 2). Kurt's fastener can be used for heavy material generally similar to the material of Taylor Made's disclosed outer cover (Finding 19). Russell's fastener is used for relatively fragile material, such as that used in baby garments, which is generally similar to Taylor Made's cotton inner liner (Finding 13). Russell and Kurt are thus pertinent to the problem of selecting appropriate closures for materials similar to those Taylor Made discloses as embodying its claimed invention (Findings 1, 2, 13, and 19). Russell and Kurt are appropriate prior art for the claimed invention.

Taylor Made argues that there is no motivation or suggestion to combine the Kurt and Russell magnetic fasteners taught with the Lauretti and Rosenow golf club head covers (Br. at 9). This argument is unpersuasive since the modification of the prior-art golf club covers to use magnetic zippers is entirely consistent with the teachings of the prior art.

Rosenow and Lauretti are from the same field of endeavor as the claimed invention (Finding 8 and 10). Rosenow and Lauretti use the same materials as Taylor Made discloses for its cover (Findings 7, 9, and 10).

Both Rosenow and Lauretti are tight fitting covers and are generally similar in design to Taylor Made's cover (Findings 7 and 10). Both Kurt and Russell teach using magnetic-strip closures to replace conventional zippers (Findings 12, 18, and 19). These magnetic strips are said to provide a convenient and easy way to form a closure (Findings 12 and 17). Additionally, Kurt teaches a magnetic zipper in place of a conventional zipper for, among other things, a cover (Findings 16 and 18).

Fabric fasteners form a mature technology. This technology includes several different types of fasteners such as buttons, hooks, snaps, zippers, zipper-like sliders, and magnets (Findings 11, 12 14, and 17). Kurt teaches that magnetic strips are better than a conventional zipper as the closure for, among other things, a cover (Findings 16 and 18). Although various fasteners can be used to close a device (Findings 8, 11, 12, 13, and 18), the prior art teaches that magnetic fasteners are a more convenient alternative (Findings 12 and 17). Those skilled in the art would have favored any simple expedient that promoted the use of a cover (Finding 21). Consequently, the examiner's proposed modification of the prior-art covers to use magnetic closures is very consistent with the teachings of the prior art.

Declaration

In its reply brief, Taylor Made urges (Reply at 6) for the first time that the Board consider a declaration that was not listed in the evidence section of its appeal brief (Br. at 15) as required in 37 C.F.R. § 41.37(c)(ix) or used in its arguments. New evidence in a reply is prohibited. 37 C.F.R. § 41.41(a)(2). The Board is not obliged to consider evidence not presented with the appeal brief. *Cf. Carbino v. West*, 168 F.3d 32, 34 (Fed. Cir. 1999)

Appeal 2008-3584
Application 10/622,006

(a late argument, even on a question of law, need not and ordinarily should not be considered).

CONCLUSION

Taylor Made has failed to show that the examiner erred in rejecting the claims over the prior art. Consequently, the rejection of claims 1, 3-6, 10, 12, 13, 16 and 17 under 35 U.S.C. § 103 is—

AFFIRMED

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